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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/216,206	12/18/1998	DAVID WILLIAM ROTH	B2745.0025/P0025	1079
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EXAMINER VAN BRAMER, JOHN W				
ART UNIT 3622		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/216,206

Applicant(s)

ROTH ET AL.

Examiner

JOHN VAN BRAMER

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49, 50, 62-96, 112-148, 164-200, 216-227, 231-269, 271 and 272 is/are pending in the application.
- 4a) Of the above claim(s) 271 and 272 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49, 50, 62-96, 112-148, 164-200, 216-227, and 231-269 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-943)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 21, 2010 has been entered.

Election/Restrictions

2. The applicant arguments directed towards independent claim 233 and dependent claims 234-269 are persuasive. As such the examiner hereby withdraws the restriction requirement for claims 233 through 269. Claims 233 through 269 are hereby rejoined and will receive and action on the merit below.

Priority

3. The applicant arguments regarding priority are not persuasive. As the applicant asserts under 35 U.S.C. 120 and C.F.R. 1.78(a)(1), in order for a non-provisional application to claim priority to an earlier filed copending non-provisional application must meet certain conditions. However, at the time the attempt the applicant attempted to claim priority for the instant non-provisional application the application for which copendency was requested was no longer a "copending non-provisional application". As

detailed in the Office Action dated June 17, 2009, the 08/787,979 application was issued as a patent on September 4, 2001 and the allegation of continuation-in-part for the present application was not possible prior to September 22, 2003, two years after the patent was granted on the 08/787,979 application. Thus the examiner is unable to grant continuation-in-part status to the present invention.

Specification

4. The substitute specifications filed January 22, 2004 and March 5, 2007 have not been entered because it does not conform to 37 CFR 1.125(a) because: The nature of the amendments renders it difficult to consider the application. On January 22, 2004 and March 5, 2007 the applicant filed a substitute specification claiming that, rather than an incorporation by reference as indicated in the Original Specification, the present application is a continuation in part of co-pending application 08/787,979 (now the '987 patent). The original invention was submitted by two inventors, Heidi Kay and Russell Fradin. As neither of these inventors are in common with the inventors of co-pending application 08/787,979, the originally filed invention was not eligible for claiming continuation-in-part status. During prosecution, the cancellation and/or amendments to the claims required the removal of Heidi Kay and Russell Fradin as inventors and the addition of David William Roth and Dylan Fyall Salisbury. This change occurred on or about the time at which claims 1-13 were cancelled and/or claims 29-39, 41-50, and 54-61. Claim 29 was added on September 22, 2003. Since Mr. Roth and Salisbury are the inventors of application 08/787,979, the ability to claim continuation-in-part status did

not occur until at least September 22, 2003. However, application 08/787,979 was issued for patent on September 4, 2001, nearly two years prior when the present application was eligible for continuation in part status. Since the present application and the 08/787,979 application were not eligible for claiming continuation-in-part status during the copendency of the applications, and the ability to claim continuation-in-part status only occurred two years after the 08/787,979 application had already issued for patent the amendment to the Specification fails to satisfy the requirements of MPEP 201.08. As such, the amendments are not entered.

Response to Amendment

5. The amendment filed on June 21, 2010 cancelled no claims. No claims were amended and no new claims were added. The applicant's argument regarding reconsideration of the withdraw of claims 233-269 was persuasive and as such claims 233-269 were rejoined. Thus the currently pending claims in the application are claims 49, 50, 62-96, 112-148, 164-200, 216-227, 231-269, 271, and 272 of which claims 271 and 272 have been withdrawn based upon restriction by original presentation. Thus the currently pending claims addressed below are claims 49, 50, 62-96, 112-148, 164-200 and 216-227, 231-269.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 49,50, 62-66, 114-118, 166-170, 218, 219, 226, 227, and 231 through 237 are rejected under 35 U.S.C. 102(b) as being anticipated by Yager (Ronald R. Yager, "Intelligent Agents for World Wide Web Advertising Decisions", International Journal of Intelligent Systems, Vol. 12, pp. 379-390, 1997).

Claim 49: Yager discloses a computerized method for determining an advertisement in response to an advertising opportunity, wherein the advertising opportunity is an opportunity to place the advertisement on a web page subsequent to a request for the web page by a viewer utilizing a browser, the computerized method comprising:

- a. Receiving in a computer network an indication of the advertising opportunity.

(Page 383, Paragraph 2)

- b. In response to receiving the indication: selecting in a computer system the advertisement from among a plurality of advertisements associated with bids submitted in real-time by the computer on behalf of advertisers desiring to fulfill the advertising opportunity wherein the computer system is embodied with computer instructions for implementing the computerized method. (Page 383, Paragraph 2)

Claim 50: Yager discloses the method of claim 49, wherein the indication of the advertising opportunity is initiated by the browser sending a reference in the web page. (Page 382, Paragraph 6)

Claim 218: Yager discloses the method of claim 49, wherein each bidding advertiser is associated with a bid, the bid being associated with indicating a monetary amount the each bidding advertiser is willing to pay if an advertisement associated with each bidding advertiser is selected and a specific event occurs. (Page 382, Paragraph 3)

Claims 62: Yager discloses a method implemented in a computer system, comprising one or more networked computers, for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the each advertising opportunity, the each advertising opportunity being an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the method comprising:

- a. Maintaining in the computer system a plurality of sets of bidding parameters, each set of bidding parameters being associated with one or more of the plurality of advertisements and an advertiser, and indicating whether the associated advertiser is desirous that a bid should be submitted for providing one of the associated one or more of the plurality of advertisements for fulfilling the each

advertising opportunity and an amount associated with such bid if to be submitted. (Page 384, Paragraph 1)

- b. Receiving in the computer system an indication of the request for content, thereby presenting the each advertising opportunity. (Page 383, Paragraph 2)
- c. In response to the request for content: submitting in the computer system one or more bids, each submitted bid being based on one of the sets of bidding parameters, the one of the sets of bidding parameters being met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs. (Page 383, Paragraph 2 through Paragraph 3)
- d. Selecting in the computer system a bid from among the submitted bids. (Page 384, Paragraph 1)
- e. Identifying in the computer system an advertisement associated with the selected bid. (Page 384, Paragraph 1)
- f. Serving with the computer system the identified advertisement in real time response to the request for the content, wherein the computer system is embodied with computer instructions for implementing the method. (Page 384, Paragraph 1)

Claim 114. Yager discloses a computer system for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the each advertising opportunity, wherein the each advertising opportunity is an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the system comprising:

- a. A computer system comprising one or more networked computers, the one or more networked computers embodied with computer instruction that:
 - i. Maintains the plurality of advertisements and a plurality of sets of bidding parameters, each set of bidding parameters being associated with one or more of the plurality of advertisements and an advertiser, and indicating whether the associated advertiser is desirous that a bid should be submitted for providing one of the associated one or more of the plurality of advertisements for fulfilling the each advertising opportunity and an amount associated with such bid if to be submitted. (Page 383, Paragraph 2; Page 384, Paragraph 1; and Page 387, Paragraph 3)
 - ii. Receives an indication of the request for content, thereby presenting the each advertising opportunity. (Page 383, Paragraph 2)
 - iii. Submits in response to the request for content, one or more bids, wherein each submitted bid is based on one of the sets of bidding parameters, wherein the one of the sets of bidding parameters is met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance

with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs. (Page 383, Paragraph 2 through Paragraph 3)

- v. Selects a bid from among the submitted bids. (Page 384, Paragraph 1)
- vi. Identifies an advertisement associated with the selected bid, whereby the system determines the identified advertisement by a bidding process. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)
- vi. Serves the identified advertisement in real time response to the request for content. (Page 384, Paragraph 1)

Claims 226 and 227: Yager discloses the method of claims 62 and 114 respectively, wherein information about a viewer utilizing the browser is stored in the computer system. (Page 380, Paragraph 2)

Claims 166 and 233. Yager discloses a method and system implemented in a computer system comprising one or more networked computers, for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the advertising opportunity, the each advertising opportunity being an opportunity to serve an advertisement to a browser, the method comprising:

- a. Receiving in the computer system an indication of the each advertising opportunity. (Page 383, Paragraph 2, and Page 384, Paragraph 1)
- b. In real time response to the indication: determining in the computer system one or more bids, each determined bid being associated with a monetary amount an advertiser associated with the each determined bid is willing to pay for the each determined bid is willing to pay for the each determined bid to be selected and a specific event to occur. (Page 383, Paragraph 2 through Paragraph 3)
- c. Selecting in the computer system a bid from among the determined bids. (Page 383, Paragraph 2 through Page 384, Paragraph 1)
- d. Identifying in the computer system one of the plurality of advertisements associated with the selected bid. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)
- e. Serving the identified advertisement to the browser, whereby the identified advertisement is determined by a bidding process, wherein the computer system is embodied with computer instructions for implementing the method. (Page 384, Paragraph 1)

Claims 63, 115, 167 and 234: Yager discloses the method and system of claims 62, 114, 166 and 233 respectively, wherein the monetary amount associated with each of the submitted bids is included in the each of the submitted bids. (Page 383, Paragraph 2 through Paragraph 3)

Claims 64, 116, 168 and 235: Yager discloses the method and system of claims 62, 114, 166 and 233 respectively, wherein the specific event for which the advertiser associated with each of the determined bids is willing to pay the monetary amount associated with the each of the submitted bids, is a same respective event for all of the submitted and determined bids. (Page 383, Paragraph 2 through Paragraph 3)

Claim 65, 117, 169, 219, 236: Yager discloses the method and system of claims 62, 114, 166, 218 and 233, wherein the specific event for which the advertiser associated with at least one of the submitted bids is willing to pay the monetary amount associated with the at least one of the submitted bids, is a serving of an advertisement associated with the at least one of the submitted bids to the browser in fulfillment of the each advertising opportunity. (Page 383, Paragraph 3)

Claims 66, 118, 170 and 237: Yager discloses the method and system of claims 65, 117, 169 and 236 respectively, wherein the specific event for which the advertiser associated with at least one determined bid is willing to pay the monetary amount associated with the at least one submitted and determined bid is a serving of an advertisement associated with the at least one submitted and determined bid to the browser in fulfillment of the each advertising opportunity. (Page 383, Paragraph 3)

Claims 231 and 232: Yager discloses the method and system of claims 62 and 114 respectively, wherein at least one of the plurality of sets of bidding parameters

includes a plurality of levels, wherein a first level includes a first criteria of advertising opportunity and a second level includes the first criteria of advertising opportunities and a second criteria of advertising opportunities. (Page 385, Paragraph 1 through Page 386, Paragraph 2)

8. Claims 49,50, 62-66, 114-118, 166-170, 218, 219, 226, 227, 231, 232-237 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber et al. (U.S. Patent Number: 5,794,210).

Claim 49: Goldhaber discloses a computerized method for determining an advertisement in response to an advertising opportunity, wherein the advertising opportunity is an opportunity to place the advertisement on a web page subsequent to a request for the web page by a viewer utilizing a browser, the computerized method comprising:

- a. Receiving in a computer network an indication of the advertising opportunity. (Col 7, lines 27-47)
- b. In response to receiving the indication: selecting in a computer system the advertisement from among a plurality of advertisements associated with bids submitted in real-time by the computer on behalf of advertisers desiring to fulfill the advertising opportunity wherein the computer system is embodied with computer instructions for implementing the computerized method. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)

Claim 50: Goldhaber discloses the method of claim 49, wherein the indication of the advertising opportunity is initiated by the browser sending a reference in the web page. (Col 14, line 59 through Col 15, line 6)

Claim 218: Goldhaber discloses the method of claim 49, wherein each bidding advertiser is associated with a bid, the bid being associated with indicating a monetary amount the each bidding advertiser is willing to pay if an advertisement associated with each bidding advertiser is selected and a specific event occurs. (Col 4, lines 47-63; and Col 14, lines 12-46; and Col 17, lines 33-63)

Claims 62: Goldhaber discloses a method implemented in a computer system, comprising one or more networked computers, for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the each advertising opportunity, the each advertising opportunity being an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the method comprising:

- a. Maintaining in the computer system a plurality of sets of bidding parameters, each set of bidding parameters being associated with one or more of the plurality of advertisements and an advertiser, and indicating whether the associated advertiser is desirous that a bid should be submitted for providing one of the

associated one or more of the plurality of advertisements for fulfilling the each advertising opportunity and an amount associated with such bid if to be submitted. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)

- b. Receiving in the computer system an indication of the request for content, thereby presenting the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)
- c. In response to the request for content: submitting in the computer system one or more bids, each submitted bid being based on one of the sets of bidding parameters, the one of the sets of bidding parameters being met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- d. Selecting in the computer system a bid from among the submitted bids. (Col 4, lines 47-63)
- e. Identifying in the computer system an advertisement associated with the selected bid. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- f. Serving with the computer system the identified advertisement in real time response to the request for the content, wherein the computer system is

embodied with computer instructions for implementing the method. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claim 114. Goldhaber discloses a computer system for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the each advertising opportunity, wherein the each advertising opportunity is an opportunity to serve an advertisement to a browser in response to a request for content by the browser, the system comprising:

- a. A computer system comprising one or more networked computers, the one or more networked computers embodied with computer instruction that:
 - i. Maintains the plurality of advertisements and a plurality of sets of bidding parameters, each set of bidding parameters being associated with one or more of the plurality of advertisements and an advertiser, and indicating whether the associated advertiser is desirous that a bid should be submitted for providing one of the associated one or more of the plurality of advertisements for fulfilling the each advertising opportunity and an amount associated with such bid if to be submitted. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)

- ii. Receives an indication of the request for content, thereby presenting the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)
- iii. Submits in response to the request for content, one or more bids, wherein each submitted bid is based on one of the sets of bidding parameters, wherein the one of the sets of bidding parameters is met by characteristics of the advertising opportunity, wherein the each submitted bid, in accordance with the one of the sets of bidding parameters, is associated with a monetary amount that an advertiser associated with the each submitted bid is willing to pay if the each submitted bid is selected and a specific event occurs. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- iv. Selects a bid from among the submitted bids. (Col 4, lines 47-63)
- v. Identifies an advertisement associated with the selected bid, whereby the system determines the identified advertisement by a bidding process. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- vi. Serves the identified advertisement in real time response to the request for content. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 226 and 227: Goldhaber discloses the method of claims 62 and 114 respectively, wherein information about a viewer utilizing the browser is stored in the computer system. (Col 12, lines 14-37; Col 13, line 49 through Col 14, line 46; Col 15, lines 17-47; and Col 15, line 57 through Col 16, line 40)

Claims 166 and 233. Goldhaber discloses a method and system implemented in a computer system comprising one or more networked computers, for determining in response to each advertising opportunity of a plurality of advertising opportunities, which advertisement of a plurality of advertisements to provide for fulfilling the advertising opportunity, the each advertising opportunity being an opportunity to serve an advertisement to a browser, the method comprising:

- a. Receiving in the computer system an indication of the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)
- b. In real time response to the indication: determining in the computer system one or more bids, each determined bid being associated with a monetary amount an advertiser associated with the each determined bid is willing to pay for the each determined bid is willing to pay for the each determined bid to be selected and a specific event to occur. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- c. Selecting in the computer system a bid from among the determined bids. (Col 4, lines 47-63)

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- d. Identifying in the computer system one of the plurality of advertisements associated with the selected bid. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)
- e. Serving the identified advertisement to the browser, whereby the identified advertisement is determined by a bidding process, wherein the computer system is embodied with computer instructions for implementing the method. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 63, 115, 167, 234: Goldhaber discloses the method of claims 62, 114, 166, 233 respectively, wherein the monetary amount associated with each of the submitted bids is included in the each of the submitted bids. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 64, 116, 168, 235: Goldhaber discloses the method of claims 62, 114, 166, 233 respectively, wherein the specific event for which the advertiser associated with each of the determined bids is willing to pay the monetary amount associated with the each of the submitted bids, is a same respective event for all of the submitted and determined bids. (Col 4, lines 47-63; Col 7, lines 27-47; and Col 14, lines 12-46)

Claim 65, 117, 169, 219, 236: Goldhaber discloses the method of claims 62, 114, 166, 218, 233, wherein the specific event for which the advertiser associated with at least one of the submitted bids is willing to pay the monetary amount associated with the at least one of the submitted bids, is a serving of an advertisement associated with the at least one of the submitted bids to the browser in fulfillment of the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 66, 118, 170, 237: Goldhaber discloses the method of claims 65, 117, 169, 236 respectively, wherein the specific event for which the advertiser associated with at least one determined bid is willing to pay the monetary amount associated with the at least one submitted and determined bid is a serving of an advertisement associated with the at least one submitted and determined bid to the browser in fulfillment of the each advertising opportunity. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 231 and 232: Goldhaber discloses the method and system of claims 62 and 114 respectively, wherein at least one of the plurality of sets of bidding parameters includes a plurality of levels, wherein a first level includes a first criteria of advertising opportunity and a second level includes the first criteria of advertising opportunities and a second criteria of advertising opportunities. (Col 4, lines 47-63; Col 7, lines 27-

47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 67-96, 112, 113, 119-148, 164, 165, 171-200, 216, 217, 220-225, 238-267 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yager (Ronald R. Yager, "Intelligent Agents for World Wide Web Advertising Decisions", International Journal of Intelligent Systems, Vol. 12, pp. 379-390, 1997).

Claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, 183, 238, 241, 244, 247, 250: Yager discloses the method and system of claims 62, 63, 64, 65, 66, 114, 115, 116, 117, 118, 166, 167, 168, 169, 170, 233, 234, 235, 236, 237 respectively. Yager further discloses the user requesting content by the browser. (Page 383, Paragraph 6). Yager is silent with regard to the protocol used in transmitting the request from the browser, however it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the standard HTTP protocol for communicating between the website and the browser as well as

provide indications using said protocol. The rationale for using the standardized HTTP protocol in order to avoid the cost and expense of developing and distributing a customized transaction protocol to all potential customers is that the HTTP protocol is one of a limited number of predictable protocols used to transmit requests from browsers.

Claims 68, 71, 74, 77, 80, 120, 123, 126, 129, 132, 172, 175, 178, 181, 184, 239, 242, 245, 248, 251: Yager discloses the method and system of claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, 183, 238, 241, 244, 247, 250 respectively, wherein the advertisement served to the browser in response to the request for content is included in a webpage accessed by the browser. (Page 384, Paragraph 1)

Claims 69, 72, 75, 78, 81, 121, 124, 127, 130, 133, 173, 176, 179, 182, 185, 240, 243, 246, 249, 252: Yager discloses the method of claims 68, 71, 74, 77, 80, 120, 123, 126, 129, 132, 172, 175, 178, 181, 184, 239, 242, 245, 248, 251 respectively, wherein the request for content by the browser is caused by a reference in the web page. (Page 384, Paragraph 1)

Claims 82-96, 134-148, 186-200, 220, 222, 253-267: Yager discloses the method of claims 67-81, 119-133, 171-185, 218, 219, 238-251 respectively, wherein the selection of the selected bid is based on the selected bid being associated with a

highest monetary amount. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)

Claims 221 and 223: Yager discloses the method of claims 218 and 219 respectively, wherein the selection of the selected bid is based on the selected bid being determined in a computer system as having a highest beneficial value over respective beneficial values of other submitted bids. (Page 386, Paragraph 3; and Page 389, Paragraph 1 through 3)

Claims 112, 164, 216, and 224: Yager discloses the method of claims 62, 114, 185 and 218 respectively, wherein each submitted bid is associated with a respective bidding agent. (Page 383, Paragraph 2 through Paragraph 3; and Page 384, Paragraph 1)

Claim 113, 165, 217 and 225: Yager discloses the method of claims 62, 114, 185 and 218 respectively, wherein each submitted bid includes a reference to an advertisement associated with the each submitted bid. (Page 383, Paragraph 2 through Paragraph 3; and Page 384, Paragraph 1)

11. Claims 67-96, 112, 113, 119-148, 164, 165, 171-200, 216, 217 and 220-225 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. (U.S. Patent Number: 5,794,210).

Claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, and 183: Goldhaber discloses the method of claims 62, 63, 64, 65, 66, 114, 115, 116, 117, 118, 166, 167, 168, 169, 170 respectively. Goldhaber further discloses the user logging onto a homepage and seeing ads that she may elect to view. (Col 7, lines 27-47). Goldhaber is silent with regard to the protocol used in transmitting the request from the browser, however it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the standard HTTP protocol for communicating between the website and the browser as well as provide indications using said protocol. The rationale for using the standardized HTTP protocol in order to avoid the cost and expense of developing and distributing a customized transaction protocol to all potential customers is that the HTTP protocol is one of a limited number or predictable protocols used to transmit requests from browsers.

Claims 68, 71, 74, 77, 80, 120, 123, 126, 129, 132, 172, 175, 178, 181, and 184: Goldhaber discloses the method of claims 67, 70, 73, 76, 79, 119, 122, 125, 128, 131, 171, 174, 177, 180, and 183 respectively, wherein the advertisement served to the browser in response to the request for content is included in a webpage accessed by the browser. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

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Claims 69, 72, 75, 78, 81, 121, 124, 127, 130, 133, 173, 176, 179, 182, and 185: Goldhaber discloses the method of claims 68, 71, 74, 77, 80, 120, 123, 126, 129, 132, 172, 175, 178, 181, and 184 respectively, wherein the request for content by the browser is caused by a reference in the web page. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claims 82-96, 134-148, 186-200, 220, and 222: Goldhaber discloses the method of claims 67-81, 119-133, 171-185, 218, and 219 respectively, wherein the selection of the selected bid is based on the selected bid being associated with an auction process. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63) While Goldhaber does not explicitly state the winning bid is associated with highest monetary amount, it would have been obvious to one of ordinary skill in the art at the time of the invention to select the highest bid for the given targeting parameters as the winning bid in the auction process. The rationale for selecting the highest bid, is that there are a limited number of predictable processes used to select the winner of an auction process and one such predictable process is the selection of the highest bidder as the winner.

Claims 221 and 223: Goldhaber discloses the method of claims 218 and 219 respectively, wherein the selection of the selected bid is based on the selected bid being determined in a computer system through an auction process and including

advertisement relevance or targeting criteria (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63). While Goldhaber does not explicitly state the winning bid is associated with highest beneficial value over respective beneficial values of other submitted bids, it would have been obvious to one of ordinary skill in the art at the time of the invention to select the highest beneficial for the given targeting parameters as the winning bid in the auction process. The rationale for selecting the highest beneficial value, is that there are a limited number of predictable processes used to select the winner of an auction process and one such predictable process is the selection of the bid that has the highest beneficial value.

Claims 112, 164, 216, and 224: Goldhaber discloses the method of claims 62, 114, 185 and 218 respectively, wherein each submitted bid is associated with a respective bidding agent. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Claim 113, 165, 217 and 225: Goldhaber discloses the method of claims 62, 114, 185 and 218 respectively, wherein each submitted bid includes a reference to an advertisement associated with the each submitted bid. (Col 4, lines 47-63; Col 7, lines 27-47; Col 14, lines 12-46; Col 14, line 59 through Col 15, line 6; and Col 17, lines 33-63)

Response to Arguments

12. Applicant's arguments filed June 21, 2010 have been fully considered but they are not persuasive.

a. The applicant argues that due to the applicants claim for priority to the '979 application, the application of the Yager art is not prior art. However, as explained in the Office Action above, the present application is not able to claim the '979 as a continuation-in-part and as such does not receive the priority filing date of the '979 application.

b. The applicant argues that Goldhaber does not provide for a real time bidding and selecting mechanism, whereby the winning bid is selected by the system in real time. However, Goldhaber specifically discloses in Col 4, lines 47-63, that the system may offer bidding without the viewer's knowledge and that an auction protocol is used to accept bids and determine the winning bid and as such the advertisement to display to the viewer. As such the limitations of the claims as currently written have been met.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN VAN BRAMER whose telephone number is

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(571)272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Van Bramer
/John Van Bramer/
Primary Examiner, Art Unit 3622